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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,109	02/04/2002	Jeffrey Todd Sumner	45954/242800	5995
826	7590	03/31/2004	EXAMINER	
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			WEBB, GREGORY E	
			ART UNIT	PAPER NUMBER
			1751	

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/067,109	<b>Applicant(s)</b> SUMNER, JEFFREY TODD	
	<b>Examiner</b> Gregory E. Webb	<b>Art Unit</b> 1751	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8,10-23,25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20-23 and 26 is/are allowed.
- 6) ☒ Claim(s) 1-6,8,10-12 and 17 is/are rejected.
- 7) ☐ Claim(s) 7,13-16,18 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Response to Amendment***

1. The following is in response to the applicant's amendments and arguments submitted 1/20/04.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Previous rejections with regard to the Bayless reference are withdrawn. Bayless fails to teach or suggest the inclusion of the specific solvents as recited by claims 1 and the specific combination of surfactants as recited by claim 20.
3. Claims 1-6, 8, 10-12 and 17 are rejected under 35 USC 102(e) as being anticipated by Opre (US 6,284,720).
4. These rejections are maintained for those reasons set forth in the prior office action as well as those arguments presented below.
5. Concerning the newly added limitation to the inclusion of specific solvents which includes the use of water as said solvent, Opre clearly teaches the use of water as a suitable solvent in amounts ranging from 0-5% water or in a dilute for up to 30% water may be added (see col. 6, lines 30-45).

***Allowable Subject Matter***

6. Claims 20-23, and 26 are allowed. The prior art fails to teach the specific combination of ingredients as defined in instant claim 20. In particular, the prior art of record does not teach,

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suggest or render obvious the applicant's specific combination of surfactants as defined in subsection (d) of instant claim 20.

7. Claims 7, 13-16, 18 and 19 are objected to. The prior art fails to teach or suggest the inclusion of those components taught in these claim. In particular the prior art fails to teach the specific surfactant of claim 7, the specific oil scavengers of claims 13-16, the blend of surfactants as described in claim 18 and the specific combination of components in the specific weight percentages as defined by claim 19.

#### ***Response to Arguments***

8. Applicant's arguments filed 1/20/04 have been fully considered but they are not persuasive.

9. With regard to the Opre rejection, the applicant argues that the current claim language presented in instant claim 1 excludes certain materials. Specifically, the applicant argues that fatty acid esters are excluded.

10. It should first be noted that the applicant's claims are drawn to a composition. Second, the applicant's transitional phrase defining the composition is "comprising." The use of terms such as "comprising" or "containing" allow for additional materials to be included in said composition. No components would be excluded using the transitional phrase "comprising."

11. The applicant's sub-composition, namely the "ester acid composition", uses the transitional phrase "consisting essentially of." This sub-composition can exclude material which would materially affect the nature and performance of the sub-composition. However, such limitations only apply to this sub-composition and not the composition as a whole. The applicant

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has provided no arguments, data, or evidence demonstrating which components are excluded by this transitional phrase.

12. As the composition as a whole can contain any additional ingredients, based on the transitional phrase "comprising", the addition of the fatty acid ester is clearly not excluded.

13. Furthermore, the applicant's composition clearly is allowed the addition of surfactants (see claim 1, lines 5-6). The compounds described by Opre, namely those fatty acids having C16-C20 fatty acid combined with a C1-C4 group meet the limitations of being a surfactant.

14. In addition, the applicant teaches the use of esters as "oil scavengers." On page 4 of the specification the applicant teaches the use of polyethylene glycol esters.

15. Finally, the applicant provides the teaching that "the solvent may be any suitable liquid that is not incompatible with the remaining components within the contaminant solubilizing compositions." (see page 8 of the instant specification). From the prior art teachings it is clear that the prior art fatty acid esters are compatible with the remaining components.

16. Therefore, the examiner does not see in anyway how the applicant's instant claim 1 is constructed to exclude any compound and in particular it in no way excludes the use of additional esters such as the prior art fatty acid esters.

### ***Conclusion***

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after


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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory E. Webb whose telephone number is 571-272-1325. The examiner can normally be reached on 9:00-17:30 (m-f).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gregory E. Webb  
Primary Examiner  
Art Unit 1751

gw